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10/056,403	01/24/2002	Thomas Lee McLaughlin	26651US10	3309

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EXAMINER

LAZOR, MICHELLE A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,403

Applicant(s)

MCLAUGHLIN ET AL.

Examiner

Michelle A Lazor

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## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-5, 12-18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other:

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no specific reference to which proceeding claim, Claim 3 or Claim 5 are dependent on. For the purposes of examination, it was assumed Claim 3 is dependent on Claim 2, and Claim 5 is dependent on Claim 4.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 4, 5, 12 – 14, 16 – 18, and 20 – 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Sanders (U.S. Patent No. 5344693).

Regarding Claims 4 and 5, Sanders discloses a method of manufacturing pressure-sensitive tape comprising the steps of feeding a substrate, inherently, along a manufacturing line, combining a layer of pressure-sensitive adhesive with a first face of said substrate, printing said layer of pressure-sensitive adhesive with a patterned adhesive-inhibiting masking to define a masking pattern comprising at least one continuous line, slitting said substrate, adhesive layer, and masking along (*i.e. running parallel to*) said at least one continuous line defined by said pattern coating to form a slit tape having an edge thickness substantially equal to the average thickness of the tape across its width (Figure 1; column 2, lines 48 – 55 and column 3, line 56 – column 4, line 2), and further processing said slit tape by releasably combining the side of said pressure-sensitive adhesive layer bearing said masking against a second substrate face, said second substrate face comprising the other face of said first-named substrate to thereby produce a self-wound tape, or comprising the face of an additional substrate to thereby produce a multisubstrate tape, in which said combining of said pressure-sensitive layer against said second substrate face is preceded by the coating of at least parts of said second substrate face with a release coating (column 4, lines 5 – 14). Thus Sanders discloses all the limitations of Claims 4 and 5, and anticipates the claimed invention.

Regarding Claims 12 – 14, Sanders discloses a method of making roll stock providing a substrate having a length extending in the machine direction, a width extending in the machine cross direction, and a substrate surface, combining said substrate with a pressure sensitive adhesive layer, said pressure sensitive adhesive layer having a length extending in the machine

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direction, a width extending in the machine cross direction, and an exposed adhesive surface remote of said substrate surface, applying adhesive inhibiting masking to said exposed adhesive surface of said pressure-sensitive adhesive layer along a plurality of continuous machine direction lines or zones extending across a portion of said width of said exposed adhesive surface to form non-adhesive lines or zones and adjacent adhesive surface lines or zones substantially free of masking, and winding said substrate and pattern coated adhesive layer into a roll; wherein said substrate also includes side edges extending in the machine direction which are substantially equal to the average thickness of the roll stock across its width (Figures 10 and 11; column 5, lines 3 – 14 and column 5, line 64 – column 6, line 4). Thus Sanders discloses all the limitations of Claims 12 – 14, and anticipates the claimed invention.

Regarding Claim 16, Sanders discloses the adhesive layer to have a width substantially equal to the width of said substrate (Figure 5). Thus Sanders discloses all the limitations of Claim 16, and anticipates the claimed invention.

Regarding Claims 17 and 18, Sanders discloses all the limitations of Claims 17 and 18 as discussed above, and anticipates the claimed invention.

Regarding Claims 20 – 22, Sanders discloses all the limitations of Claims 20 – 22 as discussed above, in addition to disclosing a method of making an article wherein said pressure sensitive adhesive layer is incorporated into said article to provide said article with said adhesive and non-adhesive surface lines or zones, wherein said step of incorporating said pressure sensitive adhesive layer into said article includes incorporating said substrate and said pressure sensitive adhesive layer in said article and separating said pressure sensitive adhesive layer from

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said substrate (column 4, line 44 – column 5, line 2); and therefore anticipates the claimed invention.

5. Claims 12 and 20 – 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Meetze (U.S. Patent No. 5980676).

Regarding Claim 12, Meetze discloses a method of making roll stock providing a substrate having a length extending in the machine direction, a width extending in the machine cross direction, and a substrate surface, combining said substrate with a pressure sensitive adhesive layer, said pressure sensitive adhesive layer having a length extending in the machine direction, a width extending in the machine cross direction, and an exposed adhesive surface remote of said substrate surface, applying adhesive inhibiting masking to said exposed adhesive surface of said pressure-sensitive adhesive layer along a continuous machine direction line or zone extending across a portion of said width of said exposed adhesive surface to form a non-adhesive line or zone and adjacent adhesive surface line or zone substantially free of masking, and winding said substrate and pattern coated adhesive layer into a roll; (Figure 2; column 10, lines 40 – 53). Although Meetze discloses a preferred embodiment which includes adhesive area (12a) which does not run all the way out to the edge of the tape, Meetze does not exclude embodiments wherein the adhesive does run all the way to the edge of the tape. Thus Meetze discloses all the limitations of Claim 12, and anticipates the claimed invention.

Regarding Claims 20 and 21, Meetze discloses a method of making an article comprising the steps of providing a substrate including a substrate surface, combining said substrate with a pressure sensitive adhesive layer, said pressure sensitive adhesive layer having a width a length and an exposed adhesive surface remote of said substrate surface, applying adhesive inhibiting

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masking in a continuous machine direction line or zone along said exposed adhesive surface of said pressure sensitive adhesive layer to form said non-adhesive surface line or zone, said non-adhesive line or zone having a width less than said adhesive layer width whereby an adjacent portion of said exposed adhesive surface of said pressure sensitive adhesive layer forms said adhesive line or zone, and incorporating said pressure sensitive adhesive layer into said article to provide said article with said adhesive and non-adhesive surface lines or zones (Figure 2; column 10, lines 8 – 53) wherein said pressure sensitive adhesive layer is incorporated into said article to provide said article with said adhesive and non-adhesive surface lines or zones, wherein said step of incorporating said pressure sensitive adhesive layer into said article includes incorporating said substrate and said pressure sensitive adhesive layer in said article (column 10, line 8 – 15). Thus Meetze discloses all the limitations of Claim 20 and 21, and anticipates the claimed invention.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanders as applied in Claim 13 above, in view of Meetze.

Sanders discloses all the limitations of Claim 13, but does not disclose said substrate to include side edges extending in the machine direction, and applying said adhesive inhibiting

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masking in a continuous line or zone at each of said side edges of said substrate to provide pick-free edges. However, Meetze discloses applying said adhesive inhibiting masking at the side edge of a substrate (Figure 2; column 10, lines 40 – 53). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to place adhesive inhibiting masking at the edges of a substrate to provide pull-off tab portions (column 10, lines 12 – 15).

*Allowable Subject Matter*

8. Claim 1 is allowed. There was no reference in the prior art search that disclosed, taught, or suggested unwinding *a roll with adhesive*, combining adhesive-inhibiting masking with the adhesive of said unwound stock along a continuous machine direction line at an intermediate point across the width of the unwound stock, and slitting said substrate, adhesive layer, and masking along said line to form at least one slit tape narrower in width than said roll of tape stock.

9. Claims 2 and 3 are allowed. There was no reference in the prior art search that disclosed, taught, or suggested combining release means with the first and second faces of a substrate with *the second face* having the easier release. Prior art teaches using release layers that have equivalent release from the first and second faces.

10. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There was no reference in the prior art search that disclosed, taught, or suggested said second non-adhesive line or zone is sized and positioned in a pattern different from that of said first mentioned non-adhesive line or zone.



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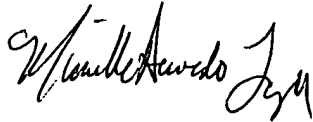
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 703-305-7976.

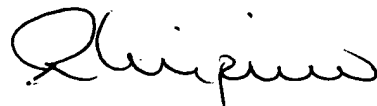
The examiner can normally be reached on Mon - Thurs 6:30 - 4:00, Fridays 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



MAL



RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700